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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANCESCO ROBBIATI and ANTONINO MONTALBANO

Appeal 2008-2884
Application 10/603,028
Technology Center 3700

Decided: August 12, 2008

Before DONALD E. ADAMS, ERIC GRIMES, and
MELANIE L. McCOLLUM, *Administrative Patent Judges*.

ADAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

This appeal under 35 U.S.C. § 134 involves claims 1 and 3-10.
Pending claims 11-22 were withdrawn from consideration (App. Br. 6). We
have jurisdiction under 35 U.S.C. § 6(b).

INTRODUCTION

The claims are directed to a packaging bag (claims 1 and 3-9) and a continuous strip of transverse-sealed packaging bags (claim 10). Claim 1 is illustrative:

1. A packaging bag comprising opposed first and second film plies joined at a closed end of the bag and sealed along lateral edges of the bag, said plies defining an open mouth end having a first edge of the first ply and a second edge of the second ply which projects beyond the first edge of the first ply and comprises a folded over film portion to exhibit double thickness at the exposed end of the second ply, wherein the margin of the folded over portion of the second ply is disposed adjacent to the edge of the first ply so that there is essentially a zero space between the first edge of the first ply and the second edge of the second ply, so as to provide a substantially constant thickness of the bag across the mouth and projecting portion, wherein the length of the folded over film portion is less than 5% of the total length of the bag.

The Examiner relies on the following prior art references to show unpatentability:

Schmidt	US 4,290,467	Sep. 22, 1981
Montepiani	US 6,260,705 B1	Jul. 17, 2001

The rejections as presented by the Examiner are as follows:

1. Claims 1 and 3-10 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Montepiani and Schmidt.

2. Claims 1 and 3-10 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 5 of Montepiani in view of Schmidt.

We affirm.

DISCUSSION

Obviousness-type double patenting:

Claims 1 and 3-10 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 5 of Montepiani in view of Schmidt.

Appellants do not argue the claims separately.¹ Therefore, we limit our discussion to representative claim 1. 37 C.F.R. § 41.37(c)(1)(vii).

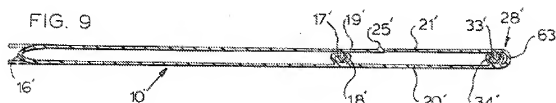
The Examiner finds that Montepiani's claims 1 and 5 define a packaging bag within the scope of claim 1 with the exception that Montepiani fails to claim an open mouth "between the edge of one ply and another edge of a folded over film portion" and "the claimed length of the folded over film portion" (Ans. 3). The Examiner relies on Schmidt to teach "that an open mouth between the edge of one ply and another edge of a folded over film portion is an equivalent structure known in the art" (*id.*). As for the length of the folded over film portion, the Examiner finds that

¹ Appellants state that "[c]laims 3-10 ultimately depend from independent claim 1 . . . [and] are also believed to be patentably distinguished over the cited combination in view of their dependency from claim 1" (App. Br. 20). This statement is not an argument for the separate patentability of claims 3-10. Claims 3-10 stand or fall with claim 1.

while neither Montepiani nor Schmidt teaches this claimed limitation, it “would have been an obvious matter of design choice at the time the invention was made to make the length of the folded over film portion whatever dimension was desired . . . since such a modification would have involved a mere change in the size of a component” (Ans. 3-4).

Appellants assert that neither Montepiani nor Schmidt teaches or suggests “a bag comprising an open mouth between the edge of one ply and another edge of a folded over film portion in accordance with independent claim 1 . . . or . . . a packaging bag wherein the length of the folded over film portion is less than 5% of the total length of the bag” (App. Br. 15).

For clarity, we reproduce figure 9 of Schmidt below:

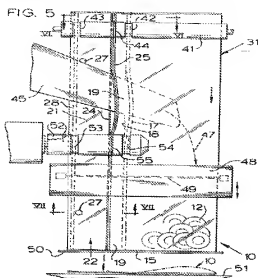


“FIG. 9 is a transverse sectional detail view showing the bag blank” (Schmidt 3: 7-8).

According to Appellants, “the Examiner appears to assert that the open area between 25’ and 21’ of Figure 9 embodies the mouth portion of the bag” (App. Br. 13). In contrast, “Appellants submit that the separable closure profiles 17’ and 18’ constitute the mouth portion of the bag disclosed in Figure 9 of” Schmidt (App. Br. 13-14). We agree that Schmidt teaches that “[c]omplementary separable fastener profiles 17 and 18 . . . are disposed across an openable top of the bag and are adapted to be separated from a closed condition into an opened condition” (Schmidt 3: 16-20). However, as

the Examiner asserts “[t]he ‘slit’ (or the open area between 25’ and 21’ of Fig. 9) of Schmidt meets the recitation of an ‘open mouth’ to [the] same degree as structurally set forth in independent claim 1” (Ans. 6).

For clarity we reproduce Schmidt’s figure 5 below:



“FIG. 5 is a schematic illustration showing how the bag strips are adapted to be filled and then separated by bag sections” (Schmidt 2: 62-64). According to Schmidt,

In a desirable form, the filling nozzle 45 . . . project[s] into the contents receiving area of the bag . . . through the slit between the pull flange 19 and the adjacent edge 24 of the front panel 21, and between the fastener profiles 17 and 18 which are progressively separated by the nozzle 45 as the strip . . . advances.

(Schmidt 4: 66 - 5: 6.)

According to the Examiner “the Schmidt reference clearly discloses the open area between 25’ and 21’ to be a portion of a bag wherein a product or article is introduced into the open bag via a filling nozzle” (Ans. 7).

Appellants assert that “the ‘mouth’ portion, as referred to in the subject specification, refers to an area into which package contents are loaded, then closed to define a sealed package” (Reply Br. 3). Accordingly, Appellants assert that

[A]lthough the bag contents can be disposed through the area between 25’ and 21’ of the bag of . . . [Schmidt], the area is not deemed the ‘mouth’ portion of the bag because it does not refer to the area through which package contents are loaded, then closed to define a sealed package.

(Reply Br. 3-4.) According to Appellants, to open Schmidt’s bag “a user would pull flange 19’ . . . to open closures 17’ and 18’” (Reply Br. 4). We are not persuaded by Appellants’ argument.

There is no requirement in claim 1 that the mouth portion of the bag is closed to define a sealed package. Accordingly, we agree with the Examiner’s assertion that by disclosing an open area between structures 25’ and 21’ “Schmidt meets the recitation of an ‘open mouth’ to [the] same degree as structurally set forth in independent claim 1” (Ans. 6).

Appellants assert that Schmidt “appears to teach away” from a “bag wherein the length of the folded over film portion is less than 5% of the total length of the bag” (App. Br. 15). In this regard, Appellants assert that “profiles 33’ and 34’ and rib 28’ [of Schmidt’s bag] is to reinforce the bag and to provide support for heavy bag contents” (App. Br. 16). Therefore, Appellants reason, if Schmidt’s bag

were equipped with an open mouth comprising a folded over portion that was less than 5% of the total length of the bag as recited in independent claim 1 of the subject application, it appears that the support function of the upper portion of [Schmidt’s bag] . . . would indeed be compromised.

(*Id.*; *see also* Reply Br. 4-5.) We are not persuaded. At best, the differences between the prior art and the claimed invention lies in the dimensional limitation recited in claim 1. There is, however, no evidence on this record to suggest Schmidt's folded over portion is not less than 5% of the total length of the bag as recited in Appellants' claim 1. Further, even if it is not, there is no evidence on this record to suggest that elements 33', 34', and 28' of Schmidt's bag could not be placed in a folded over portion that was less than 5% of the total length of the bag without compromising its support function. Stated differently, there is no evidence on this record to suggest that the dimensional limitation recited in claim 1 specifies "a device which performed and operated any differently from the prior art." *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 1349 (Fed. Cir. 1984). It is well settled that argument by counsel cannot take the place of evidence. *In re Cole*, 326 F.2d 769, 773 (CCPA 1964); *In re Geisler*, 116 F.3d 1465, 1471 (Fed. Cir. 1997).

We are also not persuaded by Appellants' assertion that the configuration of their bag is different from that taught by the prior art because it allows "easier pneumatic inflation of the bag mouth, and resistance to wrinkling" (Reply Br. 7; *see also* Spec. 4: 17-21). There is no evidence on this record that Schmidt's bag or the bag taught by the combination of references relied upon would not exhibit these properties. Accordingly, we are not persuaded by Appellants' unsupported assertion that "the presently disclosed claims are not directed merely to a 'reduction in size' as set forth by the Examiner, but rather set forth a solution to a problem experienced with prior art packaging bags" (Reply Br. 7).

In sum, we find no error in the Examiner's conclusion that:

It would have been an obvious matter of design choice at the time the invention was made to make the length of the folded over film portion whatever dimension was desired (e.g., "less than 5% of the total length of the bag", "less than 3% of the total length of the bag", "less than 1 cm", . . .), since such a modification would have involved a mere change in the size of a component.

(Ans. 5.) A minor modification of the prior art, such as limiting the length of the folded over portion of the second ply to less than 5% of the total length of the bag, does not distinguish the claimed product from the prior art. *See KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (It is proper to "take account of the inferences and creative steps that a person of ordinary skill in the art would employ."). *See also id.* at 1742 ("A person of ordinary skill is also a person of ordinary creativity, not an automaton.").

For the foregoing reasons, we affirm the rejection of claim 1 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 5 of Montepiani in view of Schmidt.

Obviousness:

Claims 1 and 3-10 stand rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Montepiani and Schmidt.

The claims have not been argued separately and, therefore, stand or fall together. 37 C.F.R. § 41.37(c)(1)(vii). Therefore, we limit our discussion to representative claim 1.

Appellants assert "[a]s set forth in detail hereinabove with regard to the response to the obviousness-type double patenting rejection, Appellants

respectfully submit that the cited combination of references does not teach each and every element of independent claim 1” (App. Br. 19; *see also* Reply Br. 8 (“the same arguments presented in response to the nonstatutory obviousness-type double patenting rejection can equally be applied to the 35 U.S.C. § 103(a) rejection of claim 1 and 3-10”)).

Accordingly, for the reasons set forth above with regard to the rejection under the judicially created doctrine of obviousness-type double patenting, we affirm the rejection of claim 1 under 35 U.S.C. § 103 (a) as unpatentable over the combination of Montepiani and Schmidt. Claims 3-10 fall together with claim 1.

CONCLUSION

In summary, we affirm the rejections of record.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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